In the United States Patent and Trademark Office

Appl. No.:	10/574,398	Confirmation No. 7428
Applicant(s):	Taylor, et al.	
Filed:	03/31/2006	
TC/A.U.:	1637	
Examiner:	Babic, Christopher	
Docket No.:	5176	
Customer No.:	35969	

CERTIFICATION OF TRANSMISSION UNDER 37 C.F.R. 1.8

I hereby certify that this correspondence, and any papers referred to in this certificate as being attached, are being facsimile transmitted to the United States Patent and Trademark Office on the date shown below.

Date: 12 April 2007 William F. Gray

William F. Gray

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action dated 12/14/2006.

In response to the restriction requirement, applicants elect the claims of restriction group (I) for further prosecution in this application. Restriction group I covers claims 1-3, which relate to a method for providing a patient diagnosis for lung cancer.

In the Office action, the examiner also requires the applicants to elect a single combination of nucleotide sequences (such as 20, 100, 200, or 366 genes) and identify the genes

of the combination in the claims. The examiner explains on page 4 of the Office action that this requirement is supported by MPEP 803.04, example (c), which he quotes.

The applicants respond that it is impossible for them to elect a single combination of nucleotide sequences from within claim 2, as data is not available to enable applicants to evaluate the possible combinations of the genes recited in claim 2 and select the subset of genes which offers the best correlation between expression levels and the presence or absence of lung cancer. Furthermore, the examiner's reliance on MPEP 803.04 is misplaced, as this section relates to applications containing only composition claims reciting different combinations of individual nucleotide sequences. The examiner does not appear to understand that the applicants are claiming the **use** of the gene sequences recited in claim 2 in the diagnostic method of claim 1, and are not claiming the gene sequences as compositions of matter. The genes which are recited in claim 2 have already been selected from the totality of genes of the human genome for use in the diagnostic method recited in claim 1, and it is not possible at this time to further select a single combination of genes within the larger set of genes recited in claim 2.

Even if the applicants had responded to the restriction requirement by electing to proceed with prosecution of restriction group IV (claim 13, drawn to a probe array), which they have not done, it is questionable whether MPEP 803.04 would apply to require an election of a single combination of gene sequences. This is because claim 13 is not a composition claim reciting different combinations of individual nucleotide sequences.

The examiner further requires election of a "Restriction Subgroup" and identifies the "probe array" and the "polypeptide array" as the Restriction Subgroups from which the applicants must pick. In response, applicants elect the probe array.

Respectfully submitted,

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